

REMARKS

In the office action mailed December 11, 2003, claims 1 and 3-40 were pending for consideration, with claims 22-40 being withdrawn. The Examiner has indicated allowable subject matter in claims 17 and 21. Applicant expresses appreciation for recognition of the identified allowable subject matter. Claims 41 through 50 have been added to incorporate the limitations of allowed claims 17 and 21 in claim 41 and 46, respectively. An indication that these new claims are allowed is respectfully requested. Claim 17 was amended to provide antecedent basis for "intensity." Further, the Examiner has rejected claims 1, 3-16 and 18-20 based on obviousness. The following specific rejections were made:

- 1) Claims 1, 4-7, 9-16 and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,085,698 (hereinafter "Ma") in view of U.S. Patent No. 5,779,777 (hereinafter "Okuda"); and
- 2) Claims 1, 3-16 and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ma in view of U.S. Patent No. 5,855,660 (hereinafter "Bujard").

Rejections Under 35 U.S.C. § 103

The Examiner has rejected claims 1, 3-6, and 18-20 as being obvious in view of various combinations of references. The Applicant respectfully submits that these claims are patentable over the cited reference for the reasons set forth below, and that the rejection should be withdrawn. The following discussion of the cited references is currently focused on the lack of each and every element and the lack of motivation. Therefore, the following discussion of applicable case law is considered an important background for the Examiner to keep in mind during this discussion.

In order to maintain a *prima facie* case of obviousness by combining references, the prior art must provide some reason or motivation to make the claimed compositions. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990).

As aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992):

"Before the PTO may combine the disclosure of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art... Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the...art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed (invention)."

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich et al.*, 220 U.S.P.Q. 504, 509-511 (CCPA 1979). There the court states that a reference must not be considered in a vacuum, but against the background of the other references of record. It is stated that the question of a § 103 case is what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

"Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by applicants." (underlining added)

It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning lead the court, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

"...it is common to find elements or features somewhere in the

prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." (underlining added)

In re Sernaker, 217 U.S.P.Q. 1, 5-6, (Fed. Cir. 1983) states a test to determine whether a rejection of an invention based on a combination of prior art elements is appropriate as follows:

"The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings...The board never showed how the teaching of the prior art could be combined to make the invention." (underlining added)

Moreover, in *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, (Fed. Cir. 1988), the court states that both the suggestion and the expectation of success must be founded in the prior art, not in the applicants disclosure. The Federal Circuit stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (Fed. Cir. 1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight (citing *Graham v. Deere*). Many inventions may seem obvious to everyone after they have been made...(citation of §103)...Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

With the above background in mind, Applicant contends that the Examiner has failed to meet its burden of making a *prima facie* case of obviousness. The Examiner has failed to show that the cited references provide sufficient teachings or motivation to combine in order to arrive at Applicant's invention. Further, Applicant contends that the combination of references is based on hindsight. Therefore, without knowledge of the disclosure of the

present invention, one of ordinary skill in the art would not be able to make the combinations proposed to arrive at the claimed invention.

The Ma Reference in view of Okuda

The Examiner has rejected claims 1, 4-7, 9-16, and 18-20 as being obvious over Ma in view of Okuda. The Ma reference merely teaches specific pigmented inks for use in ink-jet systems which exhibit improved stability, print quality, and durability. See Abstract. As the Examiner has correctly noted, Ma does not disclose an ink-jet ink composition having multi-colored reflected light or particulates having directionally dependent light reflective properties. Further, the Ma reference does not suggest specialty inks such as those claimed, but instead describes an ink-jet ink in which solids, such as pigments, are stabilized using specific block copolymers. The Ma reference lacks any suggestion to produce ink-jet ink compositions having the claimed multi-colored or directionally dependent light properties.

Further, as discussed at length in a previous communication, the Okuda reference discloses an oil-in-water emulsion for stencil printing which is incompatible with ink-jet architecture and is clearly not an ink-jettable composition.

In contrast, the present invention includes the use of a specialty ink-jet ink which includes "particulates having directionally dependent light reflective properties." The claimed ink-jet inks are clearly not merely standard colored ink-jet inks. There are no statements in either Ma or Okuda which could be construed as meeting the legal standard requiring that "something in the prior art references would suggest the advantage to be derived from combining their teachings." In Okuda, there is no suggestion that the disclosed pigments may be used in conjunction with ink-jet compositions such as those found in Ma.

The motivation cited by the Examiner is merely a motivation to use the Okuda invention as disclosed and does not lead one skilled in the art to look toward ink-jet compositions such as those described in Ma. The only motivation

to combine these two references is the Applicant's own specification. Use of Applicant's own disclosure to find motivation is impermissible hindsight. Therefore, as the Examiner has not established a *prima facie* case of obviousness, this rejection should be withdrawn.

The Ma Reference in view of Bujard

The Examiner has also rejected claims 1, 3-16, and 18-20 as being obvious over Ma in view of Bujard. The Ma reference merely teaches ink-jet inks having specific dispersants for improving dispersion and print characteristics of the disclosed ink-jet compositions having various solids. In addition, the Bujard reference discloses reflective particles having high goniochromaticity as a pigment in various compositions. As with Okuda, the disclosed particulates of Bujard can be similar to those used in the present invention. However, as in Okuda, the compositions in which the particulates are used are not ink-jetable. Specifically, the pigment is disclosed as suitable for use in paints, where the pigment is "embedded in [a] high molecular weight organic material" such as various resins, oils, rubbers, polymers and other similar materials. See col. 9, lines 11-13; col. 9, lines 27-45. The Bujard reference is clearly drawn towards high molecular weight compositions including paints, lacquers, and similar high-molecular weight compositions. In contrast, the present invention includes the use of a specialty ink-jet ink which includes "particulates having directionally dependent light reflective properties."

In Bujard, there is no suggestion that the disclosed pigments may be used in conjunction with ink-jet compositions. Further, the Bujard compositions are significantly different both in composition and application from that of the Ma reference. Therefore, there is no suggestion or motivation for one of ordinary skill in the art to combine the teachings of either reference with the other. Further, there is no motivation found in Bujard to modify any of the disclosed compositions to arrive at the ink-jetable specialty ink of the present invention as claimed by the Applicant. In addition, Ma contains no suggestion or motivation

to produce ink-jet inks having multi-colored or directionally dependent light reflective properties.

As with the Okuda reference, the motivation cited by the Examiner is not a reason or motivation to modify or combine the references to arrive at the claimed invention as required under the law. In fact, the stated motivation was "that these particles allow for glossy printed images with quick drying as taught by the abstract of Okuda et al." See Office Action mailed December 12, 2003, page 4. This statement merely provides motivation to use the invention of Okuda, i.e. it is a statement found in Okuda which highlights benefits provided by Okuda. This statement falls far short of being a suggestion to modify or combine this reference to produce the claimed ink-jet ink, but rather is a suggestion to use the pigments of Okuda in heavy paints, resins, or the like.

Even assuming that such a combination is proper, the resulting product would be a high molecular weight lacquer or paint in an ink-jet cartridge which would not satisfy the "ink-jettable" limitation of the claimed invention. Thus, Ma and Bujard fail to teach each and every element of the Applicant's present claims, and are not properly combinable as required to establish a *prima facie* case of obviousness. Therefore, the Applicant submits that the present rejection under 35 U.S.C. § 103 is improper, and respectfully requests that it be withdrawn.

Thus, in summary, there is no teaching or suggestion in any of the cited references to guide or motivate one of ordinary skill in the art to arrive at the Applicant's invention as required by law to sustain a *prima facie* case of obviousness. Further, Applicant contends that the combination of references is based on hindsight. Therefore, without knowledge of the disclosure of the present invention, one of ordinary skill in the art would not be able to make the combinations proposed to arrive at the claimed invention. Accordingly, the Applicant respectfully submits that the references also fail to identify each and every element of the claimed invention. As it is the Applicant's belief that the

Examiner has not met the initial burden of making a *prima facie* case, the Applicant respectfully requests that the rejections be withdrawn.



Conclusion

In view of the foregoing, the Applicant believes that presently pending claims 1, 3-16, 18-20, and 41-50 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone Brad Haymond at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 4th day of March, 2004.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "M. Wayne Western".

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